

**REMARKS**

Claims 25, 26, 29 and 30 are pending. The Office Action dated June 14, 2006 in this Application has been carefully considered. The above amendments and the following remarks are presented in a sincere attempt to place this Application in condition for allowance.

**1. Claim Amendments**

The Applicant has amended claims 25 and 26. Claims 1-24, 27, 28 and 31-42 have been previously canceled. Accordingly, claims 25, 26, 29, and 30 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks. *No elements have been added which were not in the originally submitted claims. Consequently, this amendment does not raise new issues that would require a further search or substantial consideration by the Examiner.*

**2. Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claim 26 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. Applicant has amended claim 26 to replace “means for pivoting” with “means for facilitating pivoting”, as suggested by the Examiner. Support for this amendment can be found in paragraph 0052.

The Examiner rejected claims 25, 26, 29, and 30 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 25 and 26 to replace “means for pivoting” with “means for facilitating pivoting”, as suggested by the Examiner. Support for this amendment can be found in paragraph 0052. Claim 25 has also been amended to recite

“means for slidingly adjusting the brace” and replace “means for slidingly adjusting the means for pivoting.” Support for this amendment may be found in paragraphs 0059 and 0063. Claim 26 has been amended to recite “the pair of bearings interfacing with the means for slidingly adjusting the brace.” Support for this amendment may be found in paragraphs 0059 and 0063.

The Examiner’s consideration of the amended claims is respectfully requested.

### 3. Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejected claims 25, 29 and 30 under 35 U.S.C. § 102(e) as being anticipated by Boehm, Jr., et al. (US 2004/0039384). Applicant respectfully traverses this rejection.

For discussion purposes, amended claim 25 is reproduced below:

25. A medical implant comprising:
    - a first bone anchor;
    - a second bone anchor; and
    - a brace comprising:
      - means for facilitating pivoting the brace from a first position to a second position, wherein in the second position the brace couples the first bone anchor to the second bone anchor;
      - means for slidingly adjusting the brace along at least a portion of the longitudinal length of the brace; and
- means for transmitting torque between the brace and at least one of the first and second bone anchors.* (emphasis supplied)

The U.S. Patent and Trademark Office provides in MPEP § 2131 that

*“[t]o anticipate a claim, the reference must teach every element of the claim....”*

Applicant respectfully submits that Boehm does not teach all of the elements of amended claim 25. Specifically, Boehm fails to disclose or suggest a “means for transmitting torque between the brace and at least one of the first and second bone anchors.”

The Examiner points to ref#68 to suggest that Boehm has a “means for transmitting torque.” This feature, a pin, is not capable of transmitting torque to the first or second anchor as required by the limitation:

means for transmitting torque between the brace and at least one of the first and second bone anchors.

In paragraph 0044, Boehm states :

[0044]...To accommodate the curved rod, each of the screws 54 has a rotational component, such as a ratcheting or a hinged mechanism, or a ball-in-socket joint 58, as shown in FIGS. 3 and 4. In the illustrated embodiment of the rotating component, the ball preferably formed on the top of the shank 56. The screw head 60 of the screw 54 conjoins to the ball of the ball-in-socket joint 58 by the socket of the latter, which surrounds the ball.

Pin 68 sits in a recess 64 of head 60. Although the Applicant admits that if torque could be transferred to the rod 66 (although Boehm does not appear to teach or suggest that the rod can receive a torque), the pin 68 could transfer a torque to the head 60. However, the Applicant cannot see how a torque applied to the head 60 can be transferred to the bone anchor from the head 60 because the head 60 appears to be coupled with the anchor in a ball-in-socket coupling (discussed in paragraph 0044). Thus, Boehm does not disclose “means for transmitting torque between the brace and at least one of the first and second bone anchors.”

Applicant respectfully submits that Boehm does not teach “means for facilitating pivoting from a first position to a second position” and “means for slidingly adjusting the brace along at least a portion of the longitudinal length of the brace,” as presented by the Examiner. The Examiner states on page 4 of the Office Action:

The device comprises means for pivoting the brace from a first position to a second position (ref#120, paragraph [0059])....means for slidingly adjusting the means for pivoting along at least a portion of the longitudinal length of the brace (spring-loaded, ref#128, 130)

The Applicant would like to remind the Examiner that claim 25 is directed to a medical implant – not to a system. In Boehm, ref#120 is a rod guiding tool and ref#128 is the arm of the rod guiding tool. The rod guiding tool is not part of a medical implant. The rod guiding tool 120 (and its arm 128) is a part of a system and not part of the medical implant itself. The Examiner has already issued a restriction requirement (Office action 12/22/2005) wherein the system (claims 11-19) was indicated to be a separate invention from the medical implant (claims 1-10 and 25-30).

Since, the system and implant were subject to a restriction requirement, the Examiner has already acknowledged that there is a distinction between claims directed to a system and claims directed to a medical implant. Therefore, in order for Boehm to anticipate claim 25, the “means for facilitating pivoting” and the “means for slidingly adjusting the brace” must be a part of the implant taught in Boehm. The rod guiding tool 120 and its arm 128 are not a part of the implant and thus cannot anticipate the limitations of claim 25. Thus, ref#120 does not teach a “means for facilitating pivoting the brace” and ref#128, 130 do not teach a “means for slidingly adjusting the brace along at least a portion of the longitudinal length” as claimed in claim 25.

It is respectfully submitted, since Boehm does not teach each and every element of claim 25, this rejection should be withdrawn.

Claims 26, 29, and 30 depend from amended claim 25 and recite further limitations in combination with the novel elements of claim 25. Therefore, the allowance of claims 25, 26, 29, and 30 is respectfully requested.

**CONCLUSION**

Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 25, 26, 29, and 30.

Applicant does not believe that any fees are due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account No. 50-0605 of CARR LLP.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

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